

canceled in the parent application. New claim 33 recites that the core material of the toner particles is unchargeable by the at least one charge director or is weakly chargeable by the at least one charge director to an extent that it is not useable in electrostatic development of latent images in the particular process. Support for this clause can be found at page 7, lines 1-6 of the specification as originally filed. New claim 34 corresponds to issued claim 22. New claims 35-40 correspond to issued claims 25-30, respectively. New claims 41-43 correspond to issued claims 8-10, respectively. New claim 44 corresponds to issued claim 12. Support for new claim 45 can be found in issued claim 18 of 6,337,168.

Thus, new claims 30-45 are fully supported by the specification and original claims. Accordingly, no new matter has being added to the claims by this Amendment.

Priority

The specification has been amended to reflect the claim to priority to the parent application 08/987,591. According to Rob Clark in the Office of Petitions, the fact that the Transmittal states that this application is a continuation of 08/987,591 and that the PTO issued a filing receipt with the correct priority information, it is not necessary for Applicant to file a Petition to claim priority.

Claim Objections

Claims 4-8 and 14-29 are objected to under 37 CFR 1.75(c) as being improper multiple dependent claims. This rejection has been rendered moot by the cancellation of claims 4-8 and 14-29.

Claims 11-13 are objected to because there is not sufficient antecedent basis for “the mixture” in the preceding claims. This rejection has been rendered moot by the cancellation of claims 11-13.

Claim Objections-35 USC § 112

Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because “it is unclear how the phrase ‘which is otherwise suitable for use

as a toner material' limits the core material." Applicants submit that this rejection is moot because claims 1-3 have been canceled. Further, this language is not present in new claims 30-45.

Also, according to the Examiner, "it is unclear what magnitude or characteristics of charge define 'weakly' charged and 'enhanced' charge." New claim 33 defines "weakly charged" as charged to an extent that it is not useable in electrostatic development of latent images in the particular process. New claim 33 further recites that the chargeability is enhanced to an extent that the coated particles can be used to develop a latent electrostatic image in the particular process for electrostatic development of electrostatic images. Claim 30 recites that the uncoated polymer particles are either unchargeable or not chargeable to an extent suitable for electrostatic development of electrostatic images. Applicants submit that this language is not indefinite. New claim 30 further recites that the chargeability is enhanced to an extent that the particles can be used to develop an electrostatic image. This same language is present in claim 18 of the issued parent (6,337,168) and applicants submit that it is not indefinite.

Claim Rejections- 35 USC §102

Claim 9 stands rejected under 35 U.S.C. 102(b) as being anticipated by Tsuneda (US Patent 3,977,983).

This rejection has been rendered moot by the cancellation of claim 9. Moreover, none of new claims 30-45 is anticipated by Tsuneda at least for the reason that they require the addition of a charge director. As Tsuneda does not disclose this step, Tsuneda cannot anticipate claims 30-45.

Claim Rejections- 35 USC §103

Claims 1, 3 and 9-13 stand rejected under 35 USC 103(a) as being unpatentable over EP 176 630 in view of Whitbread (US Patent 3,325,409) further in view of *Handbook of Imaging Materials to Diamond*, Metcalfe (US Patent 3,078,231) and Wagner (US Patent 3,438,904).

To the extent that this rejection may be applied to new claims 30-45,

Applicants respectfully traverse the rejection for the reasons stated in their responses of March 8, 2000 and July 25, 2000, in the parent application, Ser. No. 08/987,591.

Double Patenting

Claim 2 stands rejected under 35 USC 101 as claiming the same invention as that of claim 17 of U.S. Patent 6,337,168. This rejection is moot since claim 2 has been canceled.

Claims 1, 3 and 9-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent 6,337,168. This rejection is moot as claims 1, 3 and 9-13 have been canceled.

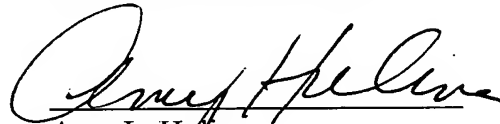
Applicants respectfully submit that none of the claims is anticipated by or rendered obvious over the references of record. Applicants believe that the present application is in condition for allowance. Accordingly, favorable consideration and allowance of this application are requested.

The Examiner is invited to contact the undersigned at (202) 220-4369 to discuss any matter concerning this application.

Respectfully submitted,

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Dated: August 8, 2002


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

The paragraph on page 1 has been amended as follows:

This application is a continuation of [Application No. 08/583,009, filed September 6, 1993,] application Ser. No. 08/987,591, which issued as U.S. Patent 6,337,168, which is a continuation of application Ser. No. 08/583,009, filed January 1, 1996, now abandoned, which is the U.S. National Stage of International Application No. PCT/NL93/00181, filed September 6, 1993. The entire disclosure of [A]application Ser. No. 08/583,009 is considered as being part of the disclosure of this application, and the entire disclosure of [A]application Ser. No. 08/583,009 is expressly incorporated by reference herein in its entirety.